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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,096	04/26/2007	Sungsuk Steve Kim	0005178.2019	5480

52390 7590 08/23/2010
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EXAMINER

SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3781

MAIL DATE	DELIVERY MODE
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08/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,096	Applicant(s) KIM ET AL.	
	Examiner JAMES N. SMALLEY	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's amendments and new claims of June 9, 2010 make a positive election of the embodiment of figures 5-7.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: at least 33a, 34a, 39b, 42a and 42b. Examiner notes there may be others, and this is not a complete list. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, from which the remaining claims depend, limits, "a lower portion of said arcuate inner surface extending radially inwardly **allowing** said arcuate surface to extend inwardly below said container neck crown..." (emphasis added). First, it is not clear how the arcuate surface extending inwardly

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"allows" the surface to extend below the crown. Secondly, the underlined portions (without boldface) appear to be redundant.

Examiner is not able to determine if the portion of the liner which extends below the container crown because it is not clear what the arcuate inner surface comprises. The Specification, paragraph [0037], notes "the liner includes an arcuately-shaped inner surface that closely approximates the radius of curvature of the container-neck crown of a standard five-gallon water bottle..." Examiner assumes this to be surface (41), an earlier sentence in the same paragraph notes "inner surface (41)" on the liner. Referring to figure 3, it is clear that the liner's lower portion extends to locking bead (39), much the same as that of Li '860. Therefore, it appears the liner of Li '860 extends below the neck crown as much as that of the instant invention, since it too stops at the locking bead, as shown in figure 4 therein.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Li US 4,700,860.

Li '860 teaches a closure comprising a snap bead (19), and a resilient liner (14). The liner extends to the bead (19), as described in col. 2, lines 32-36, and because the locking bead is located underneath the container crown, so to is the liner. Examiner notes the instant sealing liner also stops at the locking bead, and therefore, the liner of Li '860 is as below the container crown as that of Applicant's invention. The "arcuate surface" is read to be the arcuate portion of the liner connecting the horizontal section of the liner (13) with the vertical section (14a), and is read to include this vertical section. This surface is read to be an "inner surface" because it faces inwardly. It "extends" radially inwardly, relative to the closure inner surface wall.

Regarding the amendment of June 9, 2010, Examiner notes the claim preamble limits "a composite lined closure for use with a container..." (emphasis added). Thus, the prior art must only meet

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the claimed structure of the closure, and be capable of use in the intended manner. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

In this case, Examiner is not able to determine if the portion of the liner which extends below the container crown because it is not clear what the arcuate inner surface comprises. The Specification, paragraph [0037], notes "the liner includes an arcuately-shaped inner surface that closely approximates the radius of curvature of the container-neck crown of a standard five-gallon water bottle..." Examiner assumes this to be surface (41), an earlier sentence in the same paragraph notes "inner surface (41)" on the liner. Referring to figure 3, it is clear that the liner's lower portion extends to locking bead (39), much the same as that of Li '860. Therefore, it appears the liner of Li '860 extends below the neck crown as much as that of the instant invention, since it, too, stops at the locking bead, as shown in figure 4 therein, and is thus capable of being used in the intended manner.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidding et al. US 5,957,316 in view of Li US 4,700,860.

Hidding '316 teaches a closure having a top, a skirt, and a resilient bead.

The reference, as applied, fails to teach the seal extending to the resilient bead.

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Li '860 teaches a snap-on closure, and further teaches forming a seal in-situ such that it extends to the resilient bead.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure of Hidding '316, extending the seal such that it reaches the resilient bead, as taught by Li '860, motivated by the benefit of increased sealing about the container neck.

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching- suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) “by holding that courts and patent examiners should look only to the problem the patentee was trying to solve ” (*Id.* at ___, 82 USPQ2d at 1397); (2) by assuming “that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem” (*Id.*); (3) by concluding “that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try” (*Id.*); and (4) by overemphasizing “the risk of courts and patent examiners falling prey to hindsight bias” and as a result applying “[r]igid preventative rules that deny factfinders recourse to common sense” (*Id.*). In *KSR*, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at ___, 82 USPQ2d at 1395.

Furthermore, the Supreme Court issued rationales which support the conclusion of obviousness, and which can be found in the MPEP 2141(III). Under rationale (B), simple substitution of a known element for another, with predictable results, is obvious.

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9. Claims 2-3, 6-7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidding et al. US 5,957,316 in view of Li US 4,700,860 as applied above under 35 U.S.C. 103(a) to claim 1, and further in view of Adams et al. US 5,687,865.

Regarding claim 2, Hidding '316, as applied, teaches all limitations substantially as claimed, but fails to teach the seal being elastomeric.

Adams '865 teaches it is known to form a seal for water cooler bottle cap of a plastic foam, which is an elastomeric material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the seal of Hidding '316, forming it of an elastomeric material as taught by Adams '865, motivated by the benefit of a synthetic food-grade seal. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 3, the limitation comprises a method recitation within the scope of an apparatus claim. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

Regarding claim 6, Hidding '316 teaches inner cap (16b) which is read to be a surface closing the well.

Regarding claim 7, the independent claim is drawn to the closure, for use with a container. The closure of Hidding '316 is capable of being used in the intended manner because it meets all claimed structural features.

Regarding claim 13, the elastomeric seal is read to comprise a thermoplastic elastomer, as the cross hatching is consistent with synthetic resin per MPEP 608.02.

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10. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidding et al. US 5,957,316 in view of Li US 4,700,860 and in view of Adams et al. US 5,687,865 as applied above under 35 U.S.C. 103(a) to claim 1, and further in view of Ma US 6,568,563.

Regarding claim 4, Hidding '316 fails to teach the cap being formed of LDPE. The reference is silent as to the material used to form the cap.

Ma '563 teaches forming a cap of LDPE in column 3, lines 54-57.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the cap of Hidding '316 of LDPE, as taught by Ma '563, motivated by the benefit of forming the cap of an inexpensive easily-molded food-grade material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 5, the limitation comprises a method recitation within the scope of an apparatus claim. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidding et al. US 5,957,316 in view of Li US 4,700,860 as applied above under 35 U.S.C. 103(a) to claim 1, and further in view of Von Holdt US 4,512,493.

Hidding '316 teaches all limitations substantially as claimed, but fails to teach gussets extending from a lower portion of the skirt, to an adjacent bottom portion of the locking bead.

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Von Holdt '493 teaches a plurality of gussets (190) which extend from a bottom portion of a skirt to just below a locking bead (unlabeled, located below (120) in figure 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Hidding '316, providing gussets as taught by Von Holdt '493, motivated by the benefit of reinforcing the bead.

12. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidding et al. US 5,957,316 in view of Li US 4,700,860 as applied above under 35 U.S.C. 103(a) to claim 1, and further in view of Blair US 3,985,255.

Regarding claim 9, Hidding, as applied, fails to teach a pair of tear lines.

Blair '255 teaches a pair of diverging tear lines (17), for fracturing the closure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Hidding '316, providing the tear lines taught by Blair '255, motivated by the benefit of multiple fracturing to indicate tampering.

Regarding claim 10, the tear lines of Blair '255 read on the claim, because they diverge the entire time, and therefore when applied to Hidding '316, they would diverge not only below the bead, but above it as well.

Regarding claims 11-12, the diverging lines at one point are approximately twice, and further up approximately three times as thick, as the pull tab.

13. Claims 14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidding et al. US 5,957,316 in view of Li US 4,700,860 and in view of Adams et al. US 5,687,865, as applied above to claim 6, and further in view of Lamoureux US 5,687,867.

Regarding claim 14, Hiding '316, as applied above, teaches all limitations substantially as claimed, but fails to teach a monolithically formed membrane.

Lamoureux '867 teaches a monolithically formed membrane for a well in a snap-on cap.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Hidding '316, providing the integrally formed membrane taught by Lamoureux '867, motivated by the benefit of guaranteeing the inner cap will not be accidentally broken off before first use.

Regarding claims 16 and 17, Lamoureux '867 teaches an inverted cone, in which fingers are formed between weakened lines (38).

Allowable Subject Matter

14. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments filed June 9, 2010 have been fully considered but they are not persuasive.

a) Applicant argues Li '860 fails to teach a liner having an arcuate inner surface extending radially inwardly allowing the arcuate surface to extend inwardly below the container neck crown.

Li '860 teaches a closure comprising a snap bead (19), and a resilient liner (14). The liner extends to the bead (19), as described in col. 2, lines 32-36, and because the locking bead is located underneath the container crown, so to is the liner. Examiner notes the instant sealing liner also stops at the locking bead, and therefore, the liner of Li '860 is as below the container crown as that of Applicant's invention. Figure 4 shows an arcuate section connecting the horizontal section of the liner (13) with the vertical section (14a). This surface is read to be an "inner surface" because it faces inwardly. It "extends" radially inwardly, relative to the closure inner surface wall.

Moreover, Examiner notes the claim preamble limits "a composite lined closure for use with a container..." (emphasis added). Thus, the prior art must only meet the claimed structure of the closure, and be capable of use in the intended manner. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

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apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Applicant's remaining arguments all fall back on the asserted missing elements in Li '860, which Examiner has replied to above. Therefore, no further argument is deemed necessary.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/
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3781

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